



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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Washington, D.C. 20231

DATE: July 10, 1991

TO: John F. Terapane, Jr.  
Director, Group 120

FROM: Jeff Nase *JN*

SUBJECT: Outstanding Petitions Awaiting Decision for  
Correction of Inventorship

Since you do not receive a copy of the PALM report which pertains to petitions to correct inventorship rendered by your Group, a copy thereof is attached hereto. It is noted that the PALM report discloses that there is an outstanding petition which has not been acted upon, or, if acted upon, has not been entered into PALM. This case should be obtained and appropriate action taken on the petition to correct inventorship. If the petition has already been acted upon, then the decision rendered and date mailed should be entered into PALM in order to clear this petition from the report.

Attachment: Copy of PALM Report relating to Petitions to Correct Inventorship

PALM III

PETITIONS AWAITING DECISION REPORT

REPORT PERIOD: 06/01/91 THRU 06/30/91

FOR DECIDING OFFICIAL: DEPUTY A/C FOR PATENTS

SERIAL NUMBER	INT NUM	CHRG LOC	DATE IN LOCATION	STATUS DATE	EXAM NUM	EXAMINER NAME	PETITION PENDENCY		
							TYPE ROSTD	TYPE DECD	PETITION FILE DATE
05662257 06160795	910 910	07/10/90 03/01/90	151 100	11/08/85 04/16/81	333 121	SMITH, JEFFREY SCHWARTZ, RICHARD	517 517	000 000	11/18/88 05/03/89
06652712	920	03/07/91	115	09/15/87	292	64129 NO NAME FOUND	517	000	01/17/89 04/19/89
06693518	920	08/20/90	115	10/15/86	316	64229 NO NAME FOUND	517	000	05/24/89 05/31/89
06779655	920	03/12/91	115	03/12/88	332	60345 ISABELLA, DAVID	517	000	12/23/88 03/14/89
06891847	920	03/12/91	115	11/27/87	246	62108 YASICH, DANIEL	517	000	01/26/89 02/02/89
06917190	920	03/12/91	115	09/30/87	211	59967 GELLNER, MICHAEL	517	000	02/28/89 05/16/89
07000253	920	03/12/91	115	03/30/88	118	65850 JOHNSON, JERRY	517	000	03/06/89 03/20/89
07043897	920	03/12/91	115	08/17/88	216	59021 ALBRITTON, CLARENCE	517	000	03/09/89 03/21/89
07047809	920	03/12/91	115	08/23/88	111	61355 ROSENBERG, PETER	517	000	12/23/88 03/14/89
07080674	920	05/03/90	161	06/05/89	245	61969 NO NAME FOUND	517	000	01/29/89 06/06/89
07085341	920	11/27/90	115	01/04/89	216	61878 WALBERG, TERESA	517	000	05/19/89 05/31/89
07117451	920	03/12/91	115	08/07/88	155	60676 LIPMAN, BERNARD	517	000	05/04/89 05/31/89

\* \* \* \* \* TYPE 517 - TO CORRECT INVENTORSHIP IN A PATENT NOT IN INTERFERENCE

CONFIDENTIAL DATA - PRIVACY ACT PROVISIONS APPLY

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## REEXAMINATION

### DECISION

A substantial new question of patentability affecting claims 1, 2, 4, 5, 7, 9, 12 and 13 of United States Patent Number 4,282,233 to Villani is raised by the request for reexamination.

The request indicates that requester considers the following claims to be unpatentable over the indicated prior art:

Claims 1, 2, 4, 9, 12 and 13 are considered to be invalid under 35 U.S.C. § 103 over Casy in view of Witiak and Kupchan;

Claims 5 and 7 are considered to be invalid under 35 U.S.C. § 103 over Villani (C5 1972) in view of Witiak and Kupchan;

Claims 1, 2, 4, 9, 12 and 13 are also *prima facie* invalid under 35 U.S.C. § 103 in view of Casy and Protiva;

Claims 5 and 7 are also *prima facie* invalid under 35 U.S.C. § 103 in view of Villani and Protiva.

It is agreed that the references of Casy, Villani (1972), Witiak, Kupchan and Protiva raise a substantial new question of patentability as presented supra. Casy

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and Villani (C5 1972) disclose methyl piperidylidene azadibenzo cycloheptene histamine antagonist compounds, which are structurally similar to the compounds of the patent ('233). Witiak discloses investigations of certain antihistamines adsorption, distribution and metabolic fate. Kupchan discloses the evaluation of certain derivatives of normeperidine as potential analgesics, including the N-methyl derivative and the N-ethoxycarbonyl derivative. Protiva discloses the chemistry of a number of tricyclic antihistamine compounds. The references relate to compounds that are structurally similar to the compounds of the instant claims (Casy and Villani) and to other compounds and considerations involving pharmaco-chemical aspects of antihistamines and as such raise a substantial new question of patentability for claims 1, 2, 4, 5, 7, 9, 12 and 13 of the Villani patent 4,282,233. Claims 3, 6, 8, 10 and 11 of Villani 4,282,233 will also be reexamined along with claims 1, 2, 4, 5, 7, 9, 12 and 13.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37

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CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Accordingly, Office policy requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)) and provides for extensions of time in reexamination proceedings as set forth in 37 CFR 1.550(c).

RAMSUER; aco  
June 14, 1999  
June 15, 1999

  
Robert W. Ramsuer  
Art Unit 1613